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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
[illegible]	[illegible]	MORGENSTERN	[illegible]

000321 HM12/0817
SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS MO 63102

EXAMINER	
HIGEL, F	
ART UNIT	**PAPER NUMBER**
1626	4

DATE MAILED: 08/17/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- [ ] Responsive to communication(s) filed on ______
- [ ] This action is **FINAL**.
- [ ] Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- [x] Claim(s) 64 TO 70, 72 TO 77, AND 79 TO 101 is/are pending in the application.
  - Of the above, claim(s) ______ is/are withdrawn from consideration.
- [ ] Claim(s) ______ is/are allowed.
- [x] Claim(s) 64 TO 70, 72 TO 77, AND 79 TO 101 is/are rejected.
- [ ] Claim(s) ______ is/are objected to.
- [x] Claim(s) 64 TO 70, 72 TO 77, AND 79 TO 101 are subject to restriction or election requirement.

Application Papers

- [ ] See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- [x] The drawing(s) filed on ______ is/are objected to by the Examiner.
- [ ] The ~~proposed~~ drawing ~~correction~~, filed on February 5, 2001 is [x] approved [ ] disapproved.
- [ ] The specification is objected to by the Examiner.
- [ ] The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- [ ] Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - [ ] All [ ] Some* [ ] None of the CERTIFIED copies of the priority documents have been
    - [ ] received.
    - [ ] received in Application No. (Series Code/Serial Number) ______.
    - [ ] received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: ______.

- [ ] Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- [ ] Notice of Reference Cited, PTO-892
- [x] Information Disclosure Statement(s), PTO-1449, Paper No(s). ______
- [ ] Interview Summary, PTO-413
- [ ] Notice of Draftsperson's Patent Drawing Review, PTO-948
- [ ] Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Receipt is acknowledged of the preliminary amendment filed February 5, 2001, and of the information disclosure statement filed May 1, 2001, which have been entered in the file.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No._____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

The drawing filed February 5, 2001, is acceptable.

Claims 64 to 70, 72 to 77, and 79 to 1010 are rejected under 35 USC 112, second paragraph, for failing to properly define the invention. The expressions "a source of . . .", "salt precipitate", "a residual mixture", "source of H_3PO_3 comprises Pel", "the salt precipitate comprises chlorine", "combining", "any non-reactive solvent", "a metal-containing catalyst", "an electroreactive molecular species", "the electroreactive species comprises", "a promoter", "promoter comprises", "a support comprising", and "the support comprises" render the claims indefinite by placing no definite limits or boundaries on the claims.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 64 to 70 and 72 to 77, drawn to a process for the preparation of an N-substituted N-(phosphonomethyl) glycine, classified in class 562, subclass 17.

II. Claims 79 to 81, drawn to process for preparation of a N-substituted monoethanolanine, classified in class 564, subclass 503.

III. Claims 82 to 101, drawn to an oxidation catalyst, classified in class 502, subclasses 325 and 339.

The inventions are distinct, each from the other because:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different

inventions are not connected. The oxidation catalyst of invention III is not used in inventions I and II and invention II is not used in invention III or visa versa.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II or III or vise versa, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The applicant has an obligated to call the most pertinent prior art to the attention of the Patent Office in a proper fashion. Burying one reference in one hundred other IDS references is like citing nothing. *PENN YAN BOATS, INC. v. SEA LARK BOATS, INC.* 175 USPQ 260 (DC Sfla 1972). *Golden Valley Microwave Foods Inc. v. Weaver Popcorn Co. Inc.*, 24 USPQ2d 1801 (U.S. Dist. N. Dist. IN 1992).

Any inquiry concerning this communication should be directed to Floyd Higel at telephone number (703) 308-4530.

Higel:mv

August 15, 2001

FLOYD D. HIGEL
PATENT PRIMARY EXAMINER
ART UNIT ~~125~~ 1626